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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/709,046	04/08/2004	Ronald H. Segall	1129477-0002	3045
7470                      7590                      01/07/2009 WHITE & CASE LLP PATENT DEPARTMENT 1155 AVENUE OF THE AMERICAS NEW YORK, NY 10036				
EXAMINER FLETCHER III, WILLIAM P				
ART UNIT		PAPER NUMBER		
1792				
MAIL DATE		DELIVERY MODE		
01/07/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/709,046

**Applicant(s)**

SEGALL, RONALD H.

**Examiner**

William P. Fletcher III

**Art Unit**

1792

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4 and 8-25 is/are pending in the application.
- 4a) Of the above claim(s) 25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 8-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. The amendment and remarks filed on September 30, 2008, are noted with appreciation.
2. Claims 1-4 and 8-25 remain pending.

### ***Election/Restrictions***

3. Applicant's election with traverse of claims 1-24 (now 1-4 and 8-24) in the reply filed on September 30, 2008, is acknowledged. The traversal is on the ground(s) that examination of all claims does not present a serious burden. This is not found persuasive because, for purposes of the initial requirement, a serious burden on the Examiner may be *prima facie* shown if the Examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02. As set-forth in the prior Office action, process claims 1-4 and 8-24 require a search in class 427, including at least subclass 407.1, while article claim 25 requires a search in class 428, including at least subclass 411.1, where process is irrelevant (claim 25 being a product-by-process claim; see MPEP 2113). The burden on the Examiner further extends to the patentability issues associated with, and evolving as a result of, searching additional inventions. Issues related to a process are frequently very different from those related to an article. For example, the issues related to the structural requirements of an article need not be familiar to an examiner of specific processes. Consequently, examination of process claims 1-4 and 8-24 and article claim 25 present a serious burden on the Examiner both because of (1) a

divergent or non-overlapping search related to the separate classification of the inventions and (2) the evolution of patentability issues related to searching multiple and distinct inventions.

The requirement is still deemed proper and is therefore made FINAL.

4. Claim 25 remains withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on September 30, 2008.

#### ***Response to Arguments***

5. The objection set forth at paragraph 8 of the prior Office action is withdrawn in view of the amendment.

6. The rejection set forth at paragraph 10 of the prior Office action is moot in view of the cancellation of these claims.

7. The rejections set forth at paragraphs 12, 13, and 16-19, of the prior Office action are withdrawn in view of the amendment incorporating the subject matter of original claim 5 into independent claim 1.

8. The rejection set forth at paragraph 14 of the prior Office action is moot in view of the incorporation of the subject matter of original claim 5 into independent claim 1.

9. With respect to the rejection of claim 5 at paragraph 21 of the prior Office action, Applicant's arguments has been fully considered, but they are not persuasive. Applicant argues: "The person of ordinary skill in the art would not have been motivated to modify Macedo (US '116) in view of Egashira (US '345) so as to arrive at a 'green'

manufacturing process, as claimed, of directly transferring a sublimable dye image to a composite material such as a filler suspended in a matrix binder." In response to Applicant's argument that the references fail to show certain features of Applicant's invention, it is noted that the features upon which Applicant relies (i.e., "green process," direct transfer, composite material) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). As such, Applicant's arguments are not commensurate in scope with the language of the claim and are not persuasive.

10. With specific respect to the nature of Macedo's substrate and the claimed composite material, the Examiner notes that the instant specification provides no disclosure requiring that the claimed composite material be a filler suspended in a matrix binder. Further, the instant specification provides no disclosure excluding any of the substrates of Macedo from qualifying as a composite substrate. Contrary to Applicant's assertion, Macedo's substrates are not limited to cellulose webs, but may be any of the many materials recited at 2:30 and following. Patents are part of the literature of the art, relevant for all they contain, and may be relied upon for all that they would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments. Further, disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or non-preferred embodiments. See MPEP 2123. The materials listed in Macedo, such as emulsion

impregnated paper, are formed of two or more materials and read on "composite" in the broadest sense. This line of argument is not persuasive.

***Claim Rejections - 35 USC § 103***

11. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**12. Claims 1-4 and 8-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,596,116 B2 in view of US 4,908,345 A.**

A. The teaching of US '116 is detailed in the prior Office action.

B. As noted in paragraph 21 of the prior Office action, while US '116 teaches a polyester-containing coating material, this reference does not expressly teach the claimed material including an unsaturated polyester resin, styrene monomer, and methyl methacrylate.

C. US '345 teaches a composition for the formation of a sublimable dye-receiving layer from a composition comprising the elements recited in these claims. See 3:35-7:39. Such a composition exhibits improved dyeability and wear. See the abstract.

D. It would have been obvious to one skilled in the art to modify the process of US '116 so as to utilize, as the polyester composition, the composition of US '345. One skilled in the art would have been motivated to do so by the desire and expectation of providing a layer having improved dyeability and wear.

***Conclusion***

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Fletcher III whose telephone number is (571) 272-1419. The examiner can normally be reached on Sunday, 5:00 AM - 12:00 PM and Monday through Friday, 5:00 AM - 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy H. Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William Phillip Fletcher III/  
Primary Examiner, Art Unit 1792

January 4, 2009